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09/829,361	04/09/2001	Hitoshi Kawamukai	YAMAP0572USA	1248

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EXAMINER

HAILU, TADESSE

ART UNIT

PAPER NUMBER

2173

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,361

Applicant(s)

KAWAMUKAI ET AL.

Examiner

Tadesse Hailu

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the Remarks submitted on July 29, 2005 for the application number 09/829,361.

Status of the claims

2. The only pending claim 6 is examined herein as follows.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 6 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter. The body of claim 6 recites "menu item coordinate information", "image information", and "valid duration information" and including in a wherein clause reciting the insertion of "menu item coordinate information" and "valid duration information" in the transport stream data. Thus, Claim 6 recites merely arrangements and/or stored ("recorded") data on a "recording medium" so as to be read or outputted by a computing device without creating any functional interrelationship. Such descriptive material alone does not impart functionality. Thus, since claim 6 does not define a functional interrelationship among the data (the limitations), and since no computing process is performed utilizing the data, and as such is Non-Statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claim 6 is rejected under 35 U.S.C. 102(e) as being anticipated by Saeki et al Pat No 6,067,400.

Saeki et al (US Pat No 6,067,400) relates to an optical disc that stores multimedia data, a reproduction apparatus, and a reproduction method for reproducing such an optical disc.

As illustrated in Figs. 5-11, etc, Saeki discloses a recording medium (e.g., DVD) a machine-readable recording medium comprising a data area for storing at least one object that has sub-picture data and moving picture data, wherein such data stored is either system stream data or transport stream data (column 29, lines 28-48).

The transport stream data includes menu item coordinate information (see menu image 1 or menu image 2, Figs. 36 and 37, see also start and end X-Y coordinates for the menu button, Figs. 12 and 14; column 13, lines 18-58) representing a display location of a menu item.

The transport stream data also includes image information (see display images 1 through 3, Fig. 35) for representing images.

The transport stream data also includes valid duration information (valid highlight start time and highlight end time) for representing the duration for which the menu item coordinate information is valid (column 24, lines 60-column 25, lines 8; Figs. 12 and 13).

Saeki further discloses that the menu item coordinate information (e.g., Fig. 14; column 15, lines 16-34) and valid duration information (e.g., Fig. 13) are inserted or stored (see the stored highlighted data, Fig. 37) in the transport stream data at predetermined time periods. As illustrated in Fig. 14, the highlighted data includes start and end X-Y coordinates information and menu item (button) information (column 13, lines 27-58).

Response to Arguments

5. Applicant's arguments filed July 29, 2005 have been fully considered but they are not persuasive.

With regard to 35 USC § 101 rejections:

The Applicants state that claim 6 clearly recites functional interrelationship amongst the different types of data. For example, the menu item coordinate information represents a display location of a menu item. The image information represents an

image. The valid duration information represents the duration for which the menu item coordinate information is valid. Moreover, the menu item coordinate information and valid duration information is inserted in the transport stream data (including the image information for representing an image) at a predetermined time periods." The Applicants argues there is clearly functional relationship amongst the menu item coordinate information, image information and valid duration information as recited in claim 6. The Applicants further states " if there were no functional relationships, claim 6, merely would recite a recording medium having menu item coordinate information, image information and valid duration information, with no explanation whatsoever as to how the different kinds of information interrelates. That clearly is not the case with claim 6."

In contrast to the Applicants' argument, Claim 6 is directed to non-statutory subject matter because claim 6 does not define a functional interrelationship among the data (the recited limitations), and as such is non-statutory.

The body of claim 6 recites "menu item coordinate information", "image information", and "valid duration information" and including in a wherein clause reciting the insertion of "menu item coordinate information" and "valid duration information" in the transport stream data. Thus, the "information" are merely stored so as to be read or outputted by a computing device without creating any functional interrelationship between each recited information, either as part of the stored data or as part of the computing process performed by the computing device, then such descriptive material alone does not impart functionality.

The Applicants explanation does not add any functional interrelationship amongst the different types of data. For example, "the menu item coordinate information represents a display location of a menu item." This is just one descriptive material, describing what "the menu item coordinate information" represents. Also, similarly "The image information represents an image" is just another descriptive material, describing that the image information represents an image. Furthermore, The valid duration information represents the duration for which the menu item coordinate information is valid. This too is describing what valid duration is, that is, for presenting the duration for which the menu item coordinate information is valid. And lastly, the menu item coordinate information and valid duration information is inserted in the transport stream data in nothing more than describing the insertion or arrangement of menu item coordinate information and valid duration information in the transport stream data at predetermined time period. Thus, explaining the representation of each information does not add any functional interrelationship amongst the different types of data. Accordingly, claim 6 is directed to non-statutory subject matter.

With regard to **35 USC § 102 (e)** art rejection:

The Applicants state "Applicants are confused as to the basis of the rejection. The Examiner reopened prosecution of the application, presumably in view of the new grounds of rejection associated with 35 USC 101, discussed above. However, the Examiner does not address applicants' arguments in their Appeal Brief in any way. Applicants can only assume the Examiner found the arguments convincing as nothing else was added by the Examiner to facilitate ongoing prosecution." In contrast to the

Applicants' assumption, the Examiner did respond to the argument raised in the Appeal Brief. In the Brief, the Applicants generally and repeatedly argue that Saeki et al does not describe transport stream data recorded on the recording medium as specified in claim 6. This argument has been addressed in the last Office Action, thus, the Examiner does not found the argument convincing.

The Applicants again argue, "Saeki et al. does not describe transport stream data recorded on the recording medium as recited in claim 6. Instead, Saeki et al. describes the reproduction apparatus as having a reception unit for receiving the other system stream to be multiplexed in with the data recorded on the recording medium in order to form the transport stream." In contrast to the Applicants argument, Saeki et al describes transport stream data recorded on the recording medium as recited in claim 6. Saeki et al describes an information storage media in the form of an optical disk. Saeki et al describes utilizing the transport stream in said optical disk and also utilizing in a transmission medium (e.g., see column 29, lines 28-48, Figs. 4-12, 18, 20, 35-38).

The Applicants similarly argue, "As noted above [in column 29, lines 28-39] of Saeki, the reference may teach transferring data as a transport steam (i.e., "the video object will be transferred as transmit stream"). However. Saeki et al. teaches utilizing transport stream data only in the context of a transmission media (i.e., in the case of the above mentioned transmission media). Saeki et al. does not teach or suggest transport stream data for a recording medium as recited in claim 6."

In contrast to the Applicants' arguments, Saeki et al is not necessary limited to utilizing transport stream data only in the context of a transmission media (i.e., in the

case of the above mentioned transmission media). Saeki et al. does teach transport stream data for a recording medium as recited in claim 6 (e.g., see column 29, lines 28-48, Figs. 4-12, 18, 20, 35-38).

The Applicants states and argues "In other words. Saeki et al. discloses an information storage media in the form of an optical disk. However. Saeki et al. does not teach or suggest utilizing transport stream data in connection with the optical disk. Rather, Saeki et al. teaches utilizing transport stream data in the case where the media is a transmission medium as opposed to a recording medium as recited in claim 6, such as an optical disk".

Again, the examiner disagrees, Saeki et al is not necessary limited to utilizing transport stream data only in the context of a transmission media (i.e., in the case of the above mentioned transmission media). Saeki et al. does teach transport stream data for a recording medium as recited in claim 6 (e.g., see column 29, lines 28-48, Figs. 4-12, 18, 20, 35-38).

The Applicants state and argue, "In other words, the transport stream data in Saeki et al. is not stored on the recording medium (as recited in claim 6) so as to be reproduced by the motor 81, light pickup 82 and mechanism control unit 83. Rather, the reproduction apparatus in Saeki et al, in the case of transport stream data receives the transport stream data externally (i.e., not from the recording medium) though a reception unit."

The examiner disagrees because as described by Saeki et al the media do not necessary have to be information storage media like optical discs. Accordingly, Saeki

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et al is not necessary limited to the reception unit as presented by the applicants (see column 29, lines 28-39).

The Applicants states "As clearly described in the present application at page 25, lines 4-11, the invention of claim 6 is directed to a recording medium with transport stream data recorded thereon. In the case of transport stream data, Saeki et al clearly teaches selecting a branch destination to another system stream separate and apart from the recording medium (disk) having the initial system stream data recorded thereon.

Again, the examiner disagrees because as described by Saeki et al the media do not necessary have to be information storage media like optical discs. Accordingly, Saeki et al is not necessary limited to any system stream separate and apart from the recording medium as presented by the applicants (see column 29, lines 28-39). Saeki et al incorporates several media without limited to optical disk.

The Applicants therefore further states "For at least the above reasons. Saeki et al. does not teach or suggest a recording medium having each and every feature as recited in claim 6. Therefore. The rejection of claim 6 is improper. Withdrawal of the rejection of claim 6 is respectfully requested."

In contrast to the Applicants argument, Saeki describes and illustrates a recording medium having each and every feature as recited in claim 6. Therefore. The rejection of claim 6 is still proper.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 272-4051. The Examiner can normally be reached on M-F from 10:00 - 630 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (571) 272-4048 Art Unit 2173.

8. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Tadesse Hailu
Patent Examiner in Art Unit 2173
April 29, 2005

